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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,946	11/13/2003	John Terence Miller	101159-26411	2900
26511	7590	05/19/2004	EXAMINER	
HIGGS, FLETCHER & MACK LLP 2600 FIRST NATIONAL BANK BUILDING 401 WEST "A" STREET SAN DIEGO, CA 92101-7910			CEGIELNIK, URSZULA M	
			ART UNIT	PAPER NUMBER
			3712	

DATE MAILED: 05/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/713,946	MILLER, JOHN TERENCE	
	Examiner	Art Unit	
	Urszula M Cegielnik	3712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14-34 and 37-42 is/are rejected.
- 7) ☒ Claim(s) 35 and 36 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7, 9-26, 30, 32, 34, and 37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 contains the trademark/trade name VELCRO. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe hook-and-loop fasteners and, accordingly, the identification/description is indefinite.

Claim 9 recites the limitation "the first movable member" in lines 1-2.

There is improper antecedent basis for this limitation in the claim.

Regarding claims 9 and 26, the word "means" is preceded by the word(s) "magnetic" in claim 9 (claim 26, play base magnetic) in an attempt to use a "means" clause to recite a claim element as a means for performing a specified

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function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967)

Claim 38 recites "the toy is in the form of...". However, claim 15, from which claim 38 depends, recites structural limitations using alternative language. Since claim 15 was met using a pendulum, the limitations directed to a weight or toy are irrelevant.

The above are intended as examples only. Applicant is requested to thoroughly review the claims and make any necessary corrections thereto wherever appropriate but not specifically pointed out.

Claim Rejections - 35 USC § 102

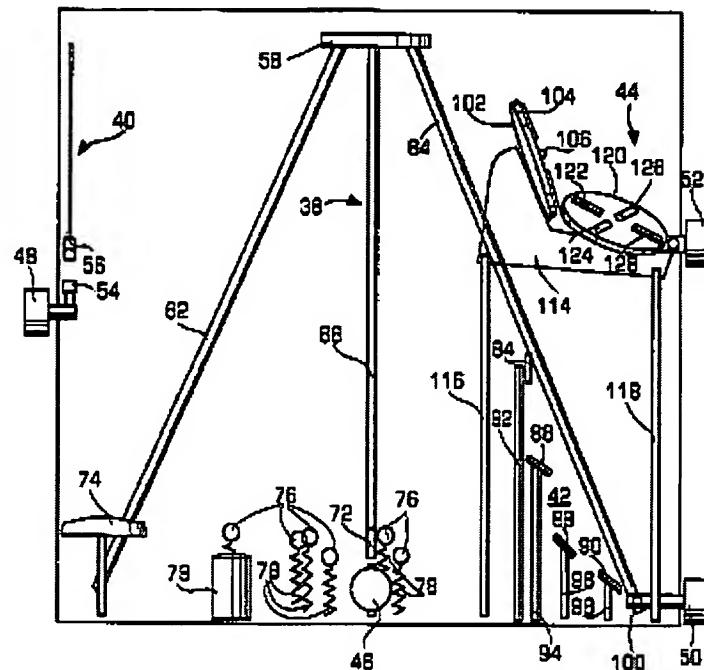
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 8, 9, 10, 11, 14, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Chabay.

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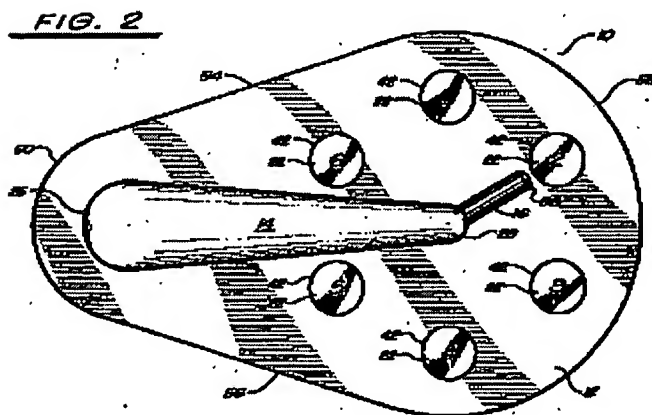
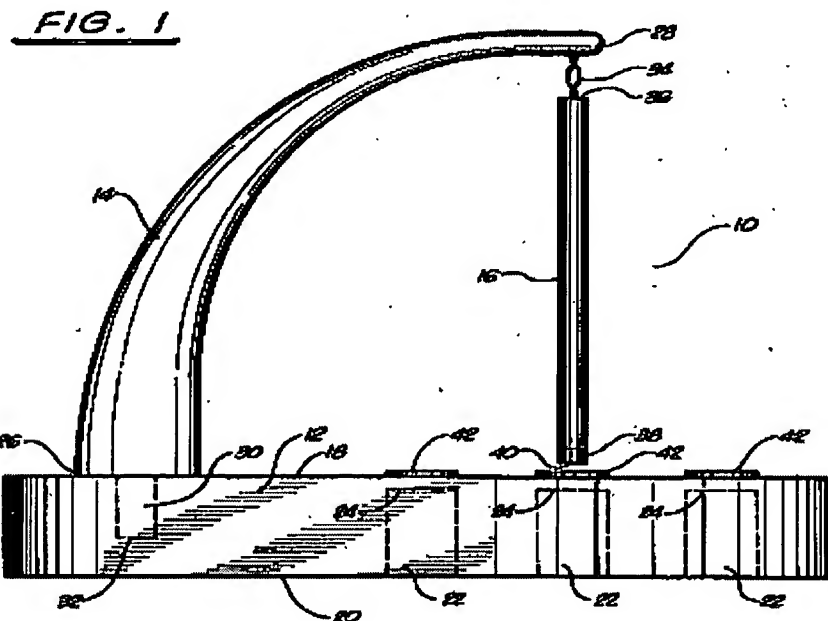


Chabay discloses an apparatus for playing a game, said apparatus including a play base and at least a first member (72) located a pre-determined spaced distance apart from said play base and movable relative thereto, the movement or at least the result of the movement of said at least first member (72) relating to one or more pre-determined criteria for allowing further playing of the game according to a set of rules; the frame includes two or more substantially upright members (62,64) with a further member (66) supported therebetween, the first member (72) attached to the supported further member (66) in use; the movable member (66) provided with magnetic means (72), the magnetic means interacting with one or more further magnetic means (col. 4, line 67 through col. 5, lines 1-2) provided on or associated with the play base; the one or more magnetic means (col. 4, line 67 though col. 5, lines 1-2) are provided with the area defined by the frame; the at least first member (includes an elongate portion

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(the portion encompassed by reference numeral 66) having a first end (the proximate portion of reference numeral 66) attached to the frame and a second free end (the distal portion of reference numeral 66) provided with the magnetic means (72); the elongate portion is substantially rigid; the magnetic means of the movable member is provided on a pendulum;

Claims 1-4, 6, 9, 16, 17, 18, 19, 20, 21, 23, 24, 25, 26, 37, 39, and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Soto, II.



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Soto, II discloses an apparatus for playing a game, said apparatus including a play base (12) and at least a first member (16) located a pre-determined spaced distance apart from said play base (12) and movable relative thereto, the movement or at least the result of the movement of said at least first member (16) relating to one or more pre-determined criteria for allowing further playing of the game according to a set of rules (col. 3, lines 7-15); the at least first member (16) is freely and randomly movable relative to the play base (12); the at least first member (16) is suspended above an upper surface of the play base (12) from a frame (14) and the member (16) is movable relative to the frame (14) and/or play base (12) in use; the at least first member (16) is pivotally mounted on the frame 14 (via a ball joint 34); the frame (14) is detachably attached to the play base (12) (col. 3, line 60); the one or more further magnetic means of the play base are located under an upper surface of the play base; the one or more further magnetic means of the play base are provided in one or more housings or compartments on the play base (12) (col. 3, lines 40-44 and Figure 1); the plurality of magnetic means are arranged at spaced intervals around the circumference of a circle (the portion encompassing reference numeral 12) (col. 2, lines 36-40); the movement of the at least first member is determined, at least in part, by the polarities of the respective magnetic means on the play base and first member (col. 3, lines 1-6); a user initiates movement of the at least first member, the magnetic interaction of the respective magnetic means determines the direction and movement of the first member (col. 5, lines 20-39); the at least first member will eventually come to rest following movement

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thereof adjacent one of the plurality of magnetic means on the play base (col. 5, lines 35-39); the at least first member is positioned at an acute angle to the vertical when the member eventually comes to rest (the first member is inherently capable of being positioned at an acute angle to the vertical by means of magnetic attraction to one of the magnets 22 on the circular play base (col. 4, lines 34-38 and Figure 2); the first movable member (16) will come to rest adjacent magnetic means (22) on the play base (12) of opposite polarity to the magnetic means (38) (col. 5, lines 31-39); the first movable member will come to rest adjacent magnetic means (22) on the play base (12) of opposite polarity to the magnetic means (38) provided with the member (16) (col. 4, lines 35-38); one or more pre-determined criteria for allowing playing of the game are associated with one or more of the play base (12) magnetic means (22) (col. 3, lines 7-15); the distance of the spaced intervals provided between the play base (12) magnetic means (22) is determined by the power and polarity of the magnetic means (38) (col. 4, lines 21-27).

Claims 1, 9, 11, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Hall.

.Hall discloses an apparatus for playing a game, the apparatus including a play base (11) and at least a first member (16) located a pre-determined spaced distance apart from the play base (11) and movable relative thereto, the movement or at least the result of the movement of the at least first member relating to one or more pre-determined criteria for allowing further playing of the game according to a set of rules; the at least first movable member (16) is

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provided with magnetic means (17), the magnetic means (17) interacting with one or more further magnetic means (19) provided on or associated with the play base (11); the elongate portion is substantially flexible (col. 2, line 39, wire is inherently flexible).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Soto, II.

Soto, II discloses the claimed invention except for the frame being integrally formed with the play base.

Applicant has not provided any criticality with respect to the frame being integrally formed with the play base in the disclosure.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the frame integrally formed with the play base, since it has been held that forming in one piece an article) which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chabay.

Chabay discloses the claimed invention including the arm members of the frame being de attached to each other (col. 4, lines 41-44).

Chabay does not teach the arm members of the frame being attached by clips, adhesive, VELCRO, screws, or friction fitting.

The Examiner takes Official Notice of the fact that arm members used in building a frame include such fastening elements as those recited immediately above in the art of construction and building.

Claims 27-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Israel in view of Soto, II.

Israel discloses a spinner (col. 6, lines 46-50); a play base (100) including a plurality of play positions (col. 4, lines 4-18) which a user is required to move a play piece therebetween during playing of the game; the play positions are defined by images, text, and symbols (col. 2, lines 4-18);

Israel does not disclose the spinner having a pendulum with a magnet.

Soto, II discloses an apparatus for playing a game, said apparatus including a play base (12) and at least a first member (16) located a pre-determined spaced distance apart from said play base (12) and movable relative thereto, the movement or at least the result of the movement of said at least first member (16) relating to one or more pre-determined criteria for allowing further playing of the game according to a set of rules (col. 3, lines 7-15); the at least first member (16) is freely and randomly movable relative to the play base (12); the at least first member (16) is suspended above an upper surface of the play base (12) from a frame (14) and the member (16) is movable relative to the

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frame (14) and/or play base (12) in use; the at least first member (16) is pivotally mounted on the frame 14 (via a ball joint 34); the frame (14) is detachably attached to the play base (12) (col. 3, line 60); the one or more further magnetic means of the play base are located under an upper surface of the play base; the one or more further magnetic means of the play base are provided in one or more housings or compartments on the play base (12) (col. 3, lines 40-44 and Figure 1); the plurality of magnetic means are arranged at spaced intervals around the circumference of a circle (the portion encompassing reference numeral 12) (col. 2, lines 36-40); the movement of the at least first member is determined, at least in part, by the polarities of the respective magnetic means on the play base and first member (col. 3, lines 1-6); a user initiates movement of the at least first member, the magnetic interaction of the respective magnetic means determines the direction and movement of the first member (col. 5, lines 20-39); the at least first member will eventually come to rest following movement thereof adjacent one of the plurality of magnetic means on the play base (col. 5, lines 35-39); the at least first member is positioned at an acute angle to the vertical when the member eventually comes to rest (the first member is inherently capable of being positioned at an acute angle to the vertical by means of magnetic attraction to one of the magnets 22 on the circular play base (col. 4, lines 34-38 and Figure 2); the first movable member (16) will come to rest adjacent magnetic means (22) on the play base (12) of opposite polarity to the magnetic means (38) (col. 5, lines 31-39); the first movable member will come to rest adjacent magnetic means (22) on the play base (12) of opposite polarity to

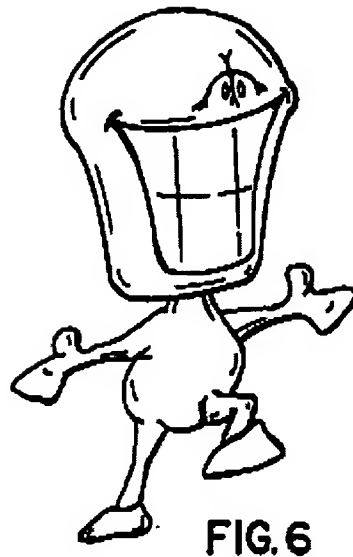
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the magnetic means (38) provided with the member (16) (col. 4, lines 35-38); one or more pre-determined criteria for allowing playing of the game are associated with one or more of the play base (12) magnetic means (22) (col. 3, lines 7-15); the distance of the spaced intervals provided between the play base (12) magnetic means (22) is determined by the power and polarity of the magnetic means (38) (col. 4, lines 21-27).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the random movement indicator as a pendulum with a magnet as taught by Soto, II, since Soto, II states at col. line 7-15, that such a modification may act as a substitution for the use of dice in a game.

Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Soto, II. In view of Lodrick, Sr.

Soto, II discloses the claimed invention except for a toy being in the form cartoon.



Falco shows figurine in the form of a cartoon.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a toy in the form of a cartoon as taught by Falco since such a modification would be more appealing to a child.

Allowable Subject Matter

Claims 35 and 36 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 13, 22, and 34 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Urszula M. Cegielnik whose telephone

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number is 703-306-5806. The examiner can normally be reached on Monday through Friday, from 5:30AM - 2:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris H. Banks can be reached on 703-308-1745. **The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306 for both regular and After Final communications.**

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Customer Service at 703-306-5648.

Urszula M. Cegielnik
Assistant Examiner
Art Unit 3712

A handwritten signature in black ink, appearing to read 'D. H. Banks', with a long horizontal line extending to the right.

DERRIS H. BANKS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700